

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Martin Volland et al.

Application No.: 10/575,843

Confirmation No.: 2215

Filed: April 13, 2006

Art Unit: 1626

For: METHOD FOR THE CONTINUOUS
PRODUCTION OF ALDEHYDES

Examiner: S. L. Chung

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

In response to the restriction requirement set forth in the Office Action mailed January 21, 2009, applicant hereby provisionally elects Group I, claims 1-7 for continued examination, with traverse.

The Examiner requests that the applicant elect one of the following inventions:

Group I, claim(s) 1-7, drawn to a process for the continuous preparation of aldehydes having 5 carbon atoms by isomerizing hydroformylation in the homogenous phase of olefin compositions have 4 carbon atoms;

Group II, claim(s) 1-7, drawn to a process for the continuous preparation of aldehydes having 6 carbon atoms by isomerizing hydroformylation in the homogenous phase of olefin compositions have 5 carbon atoms; or

Group III, claim(s) 1-7, drawn to a process for the continuous preparation of aldehyde having specific number of carbon atoms by isomerizing hydroformylation in the homogenous phase of olefin compositions have a specific number of carbon atoms.

Applicants respectfully traverse the Restriction requirement because the U.S. Patent and Trademark Office has not carried forward its burden of proof to establish distinctness.

In particular, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area.

Accordingly, Applicants respectfully traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Furthermore, the applicant believes that the election requirement made by the Examiner in view of Bohnen et al. (WO 02/068371) ("Bohnen") is not well founded, since the subject of the instant invention is clearly distinct from that of Bohnen. The subject matter of the Bohnen has been discussed in detail in the paragraph bridging pages 6 and 7 of the of the instant application. The features distinguishing the subject matter of the instant invention from that of Bohnen have been outlined in the same paragraph.

Enclosed with this response is a copy of the English translation of the Internal Preliminary Report on Patentability (IPRP) issued by the International Bureau of WIPO which reaches the conclusion that the subject matter of the PCT-application underlying the instant US-application, is not only novel over Bohnen but also involves inventive step with a view to the teaching of Bohnen and, hence, is clearly distinct from the subject matter of the Bohnen application. Apart from this, the Examiner issuing the IPRP apparently did not object lack of unity of invention.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00235-US from which the undersigned is authorized to draw.

Dated: February 12, 2009

Respectfully submitted,

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Enclosure: IPER